

REMARKS

Claims 9 and 12-13 have been amended. Claim 14 has been canceled. New Claims 15-23 have been added.

Independent Claim 9 was rejected by the Examiner under 35 U.S.C. 103(a) as being unpatentable over Horwitz et al. (USP 5,774,866) in view of Applicant's Admitted Prior Art (AAPA). Applicant traverse the rejection on the grounds that Horwitz does not teach or suggest the elements of the claims as set forth by the Examiner in the rejection.

The Examiner relies on Horwitz for teaching all elements of Claim 9 other than "displaying potential relationship data on terminals for review by all members." The Applicant respectfully suggests that the Examiner's interpretation of Horwitz is in error. While Horwitz does involve a computerized conflict checking system for organizations such as law firms, the actual method taught by Horwitz is different than the method of Claim 9. Specifically, the method of Horwitz is as follows: (1) A "Requester" enters new client data; (2) A computer system runs a **key-word search** between the new client data entry and all existing client data entries; (3) The key-word search identifies a plurality of matches between the new client data entry and existing client data entries; (4) For each match, the computer sends a conflict inquiry to an attorney (the "Evaluator") responsible for the existing client data entry; (5) The Evaluator reviews the potential conflict and either approves or disapproves; and (6) The action by the Evaluator is sent back to the conflict system administrator and the Requester.

Thus, the Horwitz system first "**filters**" all new entries through a **computerized key-word search**. Then potential conflicts are **sent only to a limited number of attorneys**, namely only those attorneys who are **associated with** a particular existing client that poses a potential conflict for the proposed new client.

In contrast to the foregoing, the method of Claim 9 essentially runs two **separate but parallel** conflict inquiries, namely a first conflict inquiry and a second conflict inquiry. The "first conflict inquiry", similar Horwitz, involves a keyword search. Unlike Horwitz however, Applicant's claimed invention does not filter potential client inquiries through a key-word search. Nor is the potential client inquiry only sent to specific attorneys identified through a key-word search.

One point of novelty of Applicant's invention is that **all** potential new client inquiries are sent to the attorneys in the organization and the attorneys are "forced" to provide input on **every** new

client inquiry. The “input” is either to acknowledge that no conflict exists or to identify those new client inquiries for which each attorney believes a conflict might exist. Notably, however, this conflict inquiry sent to a plurality of the members of the organization is separate and apart from the key-word comparison. Rather, this conflict inquiry represents the “second conflict inquiry” in the parallel conflict inquiry method of the invention.

Those skilled in the art will appreciate that key-word searches can have limited effectiveness based on the key-words entered into the system in the first place. A typographical error, a changed name, a different entity type can all result in a missed potential conflict. Rather, Applicant’s system has the advantage of drawing upon the extended, unquantifiable knowledge of the attorneys, which extended knowledge is not necessarily the type of information that can be easily entered and tracked as client data into the system. For example, an attorney may know of some industry conflict that exists between the existing clients of a law firm and the proposed new client. As a specific example, a law firm may only represent medical insurance companies and the law firm may have a policy against representing individuals making claims against medical insurance companies. As such, a conflict would exist if a proposed new client was seeking to have the law firm represent them in a medical insurance claim, even if the law firm does not represent the particular medical insurance company against which the claim is made. In such a case, a key-word search, as taught in Horwitz, would not identify such a conflict. But the attorneys of the firm would know that a conflict exists based on the description of the proposed new matter. Thus, the ability to draw upon extended knowledge of attorneys in the firm without a filter (such as a key-word search) is one novel aspect of the invention. Such a novel aspect is not taught or suggested by Horwitz.

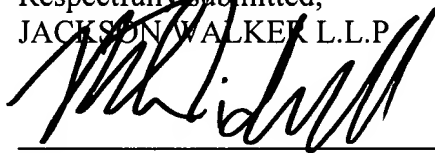
In another novel aspect of the invention, all new client inquiries are sent to the attorneys of the law firm and each attorney is required to provide computerized feedback on each new client inquiry. Thus, each new client the law firm accepts can be “certified” as having been reviewed and approved by substantially all attorneys of the firm. In addition to avoiding potential conflicts, those skilled in the art will appreciate that such a “backup” to the traditional key-word search can have the impact of lowering insurance premiums and the like. Again, Horwitz sends only select new client inquiries (as opposed to “all”) that have been identified in a key-word search to a single or small group of attorneys of the firm (as opposed to substantially all attorneys of the firm.)

For the foregoing reasons, Horwitz does not teach or suggest all of the primary components of applicant’s Claim 9, particularly arranged in the manner set forth in Applicant’s claim. Thus,

Horwitz should be withdrawn as a reference under 35 U.S.C. 103(a) and Claim 9, as well as its dependent claims, should be passed to allowance.

New claims 15-20 have been added, of which claims 15 and 20 are independent claims. The claims again recite one embodiment of the invention in which there are two separate and independent conflict determinations made prior to accepting a potential new client inquiry. One conflict determination is made by the traditional key-word search. The other conflict determination is made by submitting the new client inquiry to substantially all the members of the organization, in order to draw upon whatever extended, unquantifiable knowledge they may have related to existing clients, the new client inquiry or both. Moreover, in order to expedite processing a new client inquiry and making a decision on the proposed new client, the first and second conflict determinations can be carried out contemporaneously if not simultaneously. Again, Applicant notes that such a dual conflict inquiry system is not taught or suggested in Horwitz.

Respectfully submitted,
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